

REMARKS

Claims 1, 8, 15, and 17 have been amended. Accordingly, claims 1, 8, 15, 17, 19, 21, 23, and 25 are currently pending in the application, of which claims 1, 8, 15, and 17 are independent.

Applicants respectfully submit that the above amendments do not add new matter to the application and are fully supported by the specification. Support for the amendments may be found at least in Figures 4 and 7-8 and at the corresponding description in the specification, including at page 9, lines 12-18, and at page 13, lines 4-15 of the specification.

Applicants request reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

Amendments to the Drawings

Attached hereto are replacement figure sheets for Figures 4, 5, and 8, which include the changes, without markings, identified below.

Figure 4 has been amended to correct typographical errors at steps S409 (TERMINAL_) and S411 (PHONE_).

Figure 5 has been amended to correct typographical errors at the reverse channel ([P])DATA and TELEPHONE).

Figure 8 has been amended to label the steps as S801, S803, S805, and S807 to match the specification.

Rejections Under 35 U.S.C. § 102

In order for a rejection under 35 U.S.C. § 102(e) to be proper, a single reference must disclose every claimed feature. To be patentable, a claim need only recite a single novel

feature that is not disclosed in the cited reference. Thus, the failure of a cited reference to disclose one or more claimed features renders the 35 U.S.C. § 102(e) rejection improper.

Claims 17 and 25 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Publication No. 2003/0054863 applied for by Lee, *et al.* ("Lee").

Lee fails to disclose every feature of claim 17 as amended. Claim 17 as amended recites, in relevant part:

a radio frequency transmitter to transmit data to a service system during a voice call over a reverse traffic channel, wherein the data includes the caller information and a telephone number of a receiving party, and wherein the service system stores the data until the receiving party can receive the caller information;

In Lee, the caller image information is transmitted from a calling UE to a called UE after either a data path or a voice data path is established between the calling UE and the called UE. Lee, paragraphs [0041] to [0043]; Fig. 4. However, Lee fails to disclose at least "wherein the service system stores the data [including caller information] until the receiving party can receive the caller information." For at least these reasons, Lee fails to disclose at least these features of claim 17 as amended.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection of claim 17. Claim 25 depends from claim 17 and is allowable at least for this reason. Since none of the other prior art of record discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claim 17 and all the claims that depend therefrom are allowable.

Rejections Under 35 U.S.C. § 103

To establish an obviousness rejection under 35 U.S.C. § 103(a), four factual inquiries must be examined. The four factual inquiries include (a) determining the scope and contents of

the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966). In view of these four factors, the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. ___, slip op. at 14-15 (2007). Furthermore, even if the prior art may be combined, the combination must disclose or suggest all of the claim limitations. See *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1, 8, 15, 17, 19, 21, 23, and 25 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0126814 applied for by Awada, *et al.* ("Awada") in view of Lee.

Even if Lee and Awada could be combined as suggested by the examiner, the combined references fail to disclose or suggest every feature of claim 1 as amended.

Claim 1 as amended recites, in relevant part:

a caller terminal to store caller information, to determine whether the caller information has been sent to a receiver terminal, and if the caller information has not been sent to the receiver terminal, to transmit data including the caller information to a service system during a voice call over a reverse traffic channel after a call connection is set up;

Neither Awada nor Lee discloses or suggests at least these features. To the contrary, in Lee, caller image information is sent to another terminal if a user enters "the caller image information selection mode key." Lee, paragraphs [0026], [0031]. Then, the user must still select "one of the image data in the memory ... to be transmitted." *Id.* In Awada, the transmission of caller-id information is dependent upon whether the called communication device 150 "subscribes to the automatic directory service" provided by the services provider

165. Awada, paragraphs [0024]-[0027]. Neither Awada or Lee, however, discloses or suggests at least "a caller terminal ... to determine whether the caller information has been sent to a receiver terminal, and if the caller information has not been sent to the receiver terminal, to transmit data including the caller information."

Similarly, the combined references fail to disclose or suggest every feature of claim 8 as amended. Claim 8 as amended recites, in relevant part:

at a caller terminal, storing caller information, determining whether the caller information has been sent to a receiver terminal, and if the caller information has not been sent to the receiver terminal, transmitting data including the caller information to a service system during a voice call over a reverse traffic channel after a call connection is set up;

For at least the reasons set forth above with respect to claim 1, neither Awada nor Lee discloses or suggests at least these features of claim 8 as amended.

Similarly, the combined references fail to disclose or suggest every feature of claim 15 as amended. Claim 15 as amended recites, in relevant part:

wherein the caller information is automatically updated in the mobile terminal by linking an updated image or updated telephone number contained in the data with a preexisting telephone number stored in a telephone directory.

Neither Awada nor Lee discloses or suggests at least these features of claim 15 as amended. Specifically, neither Awada nor Lee discloses "automatically updat[ing]" caller information. The examiner relies upon Awada's paragraph [0034] to disclose the "automatically" feature of claim 15. Specifically, in the Advisory Action dated September 19, 2008, the examiner cites to Awada's paragraph [0034], which recites in relevant part, "a local directory for a communications device may be automatically established and updated based on caller-id information." Although the term "automatically" modifies only "established" in this paragraph,

the examiner asserts that it also modifies "updated." Advisory Action, page 2. Applicants disagree.

Awada is clear that the user of the receiving terminal must make a selection from among options 420, 430, 440, and 450 upon receiving the caller-id information from the calling party. Awada, Fig. 4; paragraph [0045]. Only one of these options—420—will add the caller-id information to the local directory, and since it requires a user input, the storing is not automatic. See also, e.g., paragraph [0009] (where the called party "is given the option to store the caller-id information as a directory entry."); paragraph [0027] (where "options to store the caller-id information in a local directory may also be provided" in addition to displaying the information on the device); paragraph [0051] (where the caller-id information is compared against directory entries "prior to providing the user with an option to add the caller-id information to the called party personal directory."). Thus, Awada is clear that updating the caller-id information in the receiving terminal is dependent upon a selection made by the user, and therefore is not automatic.

Thus, contrary to the examiner's position in the Advisory Action, Awada's paragraph [0034] is consistent with the above-quoted portions of Awada's specification, and fails to disclose at least "the caller information is automatically updated."

Finally, Lee fails to remedy the shortcomings of Awada.

The combined references fail to disclose or suggest every feature of claim 17 as amended. As set forth above, Applicants submit that Lee alone fails to disclose every feature of claim 17 as amended. Further, Awada fails to remedy the shortcomings of Lee alone.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 8, 15, and 17. Claims 19, 21, 23, and 25 respectively depend from claims

1, 8, 15, and 17, and are allowable at least for this reason. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1, 8, 15, and 17, and all the claims that depend therefrom, are allowable.

CONCLUSION

A full and complete response has been made to the pending Office Action, and all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, all pending claims are allowable and the application is in condition for allowance.

The Examiner is invited to contact Applicants' undersigned representative at the number below if it would expedite prosecution. Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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Date: October 8, 2008

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